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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,580	12/27/2000	Edward G. Yong	1944	1637
32710	7590	12/17/2004		
Stites & Harbison PLLC TransPotomac Plaza 1199 North Fairfax Street, Suite 900 Alexandria, VA 22314-1437			EXAMINER KANG, PAUL H	
			ART UNIT	PAPER NUMBER
			2141	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Applicati n N . 09/752,580	Applicant(s) YONG, EDWARD G. 	
	Examiner Paul H Kang	Art Unit 2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen, US Pat. No. 6,108,688, in view of Knowles et al., US Pat. No. 5,905,863.

2. As to claims 1, 10, 18 and 21, Nielsen teaches the invention substantially as claimed. Nielsen teaches a method for responding to an electronic mail message selected by a user, where the user accesses a mailbox adapted to store one or more electronic mail messages, each electronic mail message having a unique identifier and an identifier storage field (Nielsen, col. 1, line 11 – col. 2, line 30), the method comprising the steps of:

retrieving the unique identifier of the selected electronic mail message (Nielsen, col. 1, line 11 – col. 2, line 30).

However, Nielsen does not explicitly teach searching the mailbox for at least one related electronic mail message having the unique identifier of the selected electronic mail message in the identifier storage field of said related electronic mail message; and providing information relating to results of said searching the mailbox step.

In the same field of endeavor, Knowles teaches searching the mailbox for at least one related electronic mail message having the unique identifier of the selected electronic mail message in the identifier storage field of said related electronic mail message; and providing information relating to results of said searching the mailbox step (Knowles, col. 1 line 36 – col. 3, line 63 and col. 4, lines 7-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the search features as taught by Knowles, into the email system of Nielsen, for the purpose of creating an effective message threading system.

3. As to claims 2 and 3, Nielsen-Knowles teach the method further comprising the step of displaying to the user said information relating to said results of said searching the mailbox step, executed in response to a request from the user to respond to the selected electronic mail message (Nielsen, col. 1, line 11 – col. 2, line 30; Knowles, col. 1 line 36 – col. 3, line 63 and col. 4, lines 7-50).

4. As to claims 4, 5 and 12, Nielsen-Knowles teach the results of the search comprises a count of said related emails and the unique identifier (Nielsen, col. 1, line 11 – col. 2, line 30; Knowles, col. 1 line 36 – col. 3, line 63 and col. 4, lines 7-50).

5. As to claims 6-9, 15, 16, 17, 19, 20 and 22, Nielsen-Knowles teach the method wherein each electronic mail message further comprises a time field for storing a sent time, and wherein said searching the mailbox step further comprises the step of searching the time field of each said

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related electronic mail message for a sent time later than the sent time of the selected electronic mail message, wherein the results are determined by the searching step and displayed to the user (Nielsen, col. 1, line 11 – col. 2, line 30 and col. 3, line 8 – col. 4, line 31).

6. As to claim 11, Nielsen-Knowles teach the method wherein said related emails are determined to be sent in response to the first email if the unique identifier of the first email is stored in the identifier storage field of said related email (Nielsen, col. 1, line 11 – col. 2, line 30 and col. 3, line 8 – col. 4, line 31; Knowles, col. 9, lines 63-67 and col. 10, lines 16-20).

7. As to claim 13, Nielsen-Knowles teach listing related emails wherein the listing includes at least one of a sender, recipient, subject, sent time and a message body (Nielsen, col. 1, line 11 – col. 2, line 30 and col. 3, line 8 – col. 4, line 31; Knowles, col. 9, lines 63-67 and col. 10, lines 16-20).

8. As to claim 14, Nielsen-Knowles teach generating a reply email (Nielsen, col. 1, line 11 – col. 2, line 30 and col. 3, line 8 – col. 4, line 31; Knowles, col. 9, lines 63-67 and col. 10, lines 16-20).

Response to Arguments

9. Applicant's arguments filed September 10, 2004 have been fully considered but they are not persuasive.

The applicants argued in substance that there was no suggestion to combine the references since the two references deals with problems different the present invention, and

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different from each other. Applicant argues that the combination of such references is necessarily improper hindsight.

The examiner respectfully disagrees. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Additionally, applicant's argument (that the prior art of record deals with 1) reminding a sender of an email, and 2) finding an email message to which another email message is a response, are purposes which have nothing to do with one another; and further unlike the intended use of the invention as claimed), a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Here, Nielson was relied upon for the mailbox and unique identifier. Knowles was relied upon for finding related messages in the mailbox based on unique identifiers. The two features are functionally complementary in the art of electronic mail processing.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

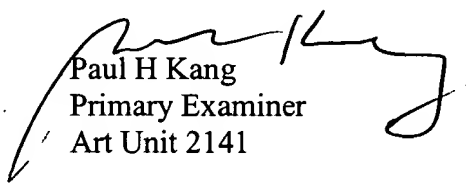
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul H Kang
Primary Examiner
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